

## **REMARKS**

Applicant has carefully reviewed the Final Office Action mailed September 25, 2007, and the Advisory Action mailed December 4, 2007, prior to preparing this paper. Currently claims 1-9, 11, 13-16, 18-26 and 30 are pending in the application, wherein claims 1-4, 8, 9, 11, 13-16, 19, 22-26 and 30 have been rejected and claims 5-7, 18, 20 and 21 have been withdrawn from consideration. Claims 1, 13, 16, 19, 22 and 26 have been amended and claims 18 and 20-21 have been cancelled with this paper. Support for the amendments to the claims may be found, for example, on page 12, lines 13-14 and lines 21-22 and page 13, lines 19-22 of the application. No new matter has been added with these amendments. Favorable consideration of the above amendments and following remarks is respectfully requested.

### **Request for Non-Entry of Amendment After Final filed November 20, 2007**

As indicated in the Request for Continued Examination, Applicants request non-entry of the Amendment and Response filed on November 20, 2007. The Request for Continued Examination and the Amendment presented herein should be considered fully responsive to the Final Office Action mailed September 25, 2007, and the Advisory Action mailed December 4, 2007.

### **Claim Rejections Under Informalities**

Claims 16, 22-26 and 30 have been rejected because of informalities as indicated in the Office Action. Appropriate amendments to the claims have been made with this paper. Thus, it is believed these objections have been overcome. Withdrawal of the objection is respectfully requested.

### **Claim Rejections Under §102**

Claims 1, 8 and 9 stand rejected under 35 U.S.C. §102(b) as being anticipated by Palermo et al., U.S. Patent No. 5,769,796. Applicant respectfully traverses this rejection. Claim 1 has been amended to recite:

A guidewire comprising:  
an elongated inner core member including a proximal section and a distal, the distal section including a proximal portion and a distal portion;  
an elongated reinforcing member having a proximal end and a distal end, the elongated reinforcing member disposed about the proximal portion of the distal section such that the distal portion of the distal section is free of the reinforcing member; and

- an outer coil member having a proximal end and a distal end, the outer coil member disposed about the distal section of the core member, there being no intervening layer of material between the distal portion of the distal section of the inner core member and the outer coil member; and
- the outer coil member located exterior of the elongated reinforcing member such that there exists a space between the entire perimeter of the elongated reinforcing member and the outer coil member;
- wherein the proximal end of the outer coil member is located proximal of the proximal end of the elongated reinforcing member.

MPEP 2131 states that, in order to anticipate a claim, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim.' *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)." Applicant respectfully asserts that Palermo et al. do not disclose that which is currently claimed in claim 1. For instance, Palermo et al. fail to teach a reinforcing member in which there is a space between the entire perimeter of the elongated reinforcing member and the outer coil member, as is currently claimed. Palermo et al. teach a solder joint (128) between the inner and outer members, which would not leave a space between the inner and outer members. For at least these reasons, Applicant asserts that claim 1 is now in condition for allowance. Claims 8 and 9, which depend from claim 1, are also believed to be in condition for allowance. Withdrawal of the rejection is respectfully requested.

Claims 13-16 and 22-25 stand rejected under 35 U.S.C. §102(e) as being anticipated by Reynolds et al., U.S. Patent No. 7,074,197. Applicant respectfully traverses this rejection. Claim 13 has been amended to recite:

- A guidewire comprising:
  - an elongated inner core member, the core member having a proximal region and a distal region with at least a portion of the distal region including stainless steel, the distal region having a proximal section and a distal section;
  - an elongated tubular reinforcing member including a nickel-titanium alloy disposed about the inner core member, the reinforcing member having a proximal end and a distal end, wherein the distal end terminates proximal of the distal section of the distal region of the core member;
  - wherein the reinforcing member comprises a tube having at least one cut or groove defined therein; and
  - an outer coil member having a proximal end and a distal end, the outer coil member disposed over the distal section of the core member and at least a portion of the reinforcing member;
  - wherein the proximal end of the outer coil member is located proximal of the proximal end of the reinforcing member.

Furthermore, claim 22 has been amended to include the limitation of a tubular reinforcing member having at least one cut or groove. MPEP 2131 states that, in order to anticipate a claim, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)." Applicant respectfully asserts that Reynolds et al. do not disclose that which is currently claimed in either of claims 13 and 22. For instance, Reynolds et al. fail to teach a reinforcing member comprising a tube having at least one cut or groove defined therein, as currently claimed.

In formulating the rejection, it appears as though the coil 390 of Reynolds et al. is being equated with the claimed reinforcing member. However, in looking to Figure 11 of Reynolds et al., the coil is shown as such, a coil. For at least this reason, Reynolds et al. fail to anticipate claims 13 and 22. Applicant asserts claims 13 and 22 are believed to be in condition for allowance. Claims 14-16 and claims 23-25 which depend from claim 13 and 22, respectively, are also believed to be in condition for allowance. Withdrawal of the rejection is respectfully requested.

#### **Claim Rejections Under §103**

Claims 2-4 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Palermo et al., U.S. Patent No. 5,769,796, in view of O'Connor et al., U.S. Patent No. 6,887,235. Applicant respectfully traverses this rejection.

Claims 2-4 depend from claim 1. As discussed above, Palermo et al. fail to teach each and every limitation of claim 1. O'Connor et al. fail to remedy the shortcomings of Palermo et al. Namely, O'Connor et al. do not teach a reinforcing member in which there is a space between the entire perimeter of the elongated reinforcing member and the outer coil member, as is currently claimed. The outer sheath 24 of the catheter of O'Connor is disposed directly over the reinforcing tube 18. For at least this reason, a *prima facie* case of obviousness has not been established for claims 2 and 4. Withdrawal of the rejection is respectfully requested.

Claim 11 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Palermo et al., U.S. Patent No. 5,769,796, in view of Urick et al., U.S. Patent No. 5,666,969. Applicant respectfully traverses this rejection.

Claim 11 depends from claim 1. As mentioned above, Palermo et al. fail to teach each and every limitation of claim 1. Urick et al. fail to remedy the shortcomings of Palermo et al.

For at least this reason, a *prima facie* case of obviousness has not been established for claim 11. Withdrawal of the rejection is respectfully requested.

Claims 19, 26 and 30 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Reynolds et al., U.S. Patent No. 7,074,197, in view of O'Connor et al., U.S. Patent No. 6,887,235. Applicant respectfully traverses this rejection.

Reynolds et al., which has a filing date of February 28, 2002 and an issue date of July 11, 2006, is available as prior art to the current application, if at all, under §102(e). However, §103(c) applies in this instance to remove the reference as prior art against the current application under 35 U.S.C. §103(a). See M.P.E.P. §2136.01. Both Reynolds et al. and the current application were subject to an obligation of assignment to the same person at the time the invention was made. The Reynolds et al. assignment to SciMed Life Systems, Inc. can be found at Reel 013190, Frame 0612 and the assignment of the current application to SciMed Life Systems, Inc. can be found at Reel 014531, Frame 0338. Therefore, Reynolds et al. is disqualified as prior art in formulating the obviousness rejection under the provisions of §103(c). Both, Reynolds et al. and the current application, have subsequently been assigned to Boston Scientific SciMed, Inc. Withdrawal of the rejection is respectfully requested.

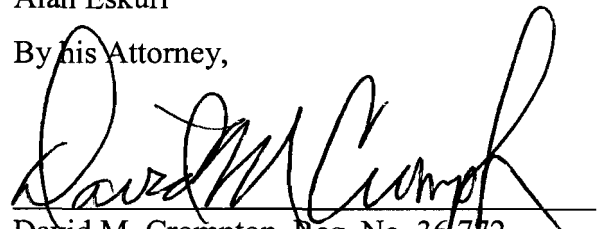
### **Conclusion**

Reexamination and reconsideration are respectfully requested. It is respectfully submitted that all pending claims are now in condition for allowance. Issuance of a Notice of Allowance in due course is requested. If a telephone conference might be of assistance, please contact the undersigned attorney at (612) 677-9050.

Respectfully submitted,

Alan Eskuri

By his Attorney,



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